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DEC 26 2003

703-872-9310 OFFICIAL #14 2/10/04

FAX RESPONSE
DCS-TWOSIDEDSTICKEYS

Applicant : David C. Schwartz
Serial no : 09/735,375
Filed : 12/12/2000
For : TWO SIDED STICKYS
Group art unit : 3722
Examiner : Nasser Ahmad

<<<7(seven) Pages>>>

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

Southboro, MA 12/26/2003

RESPONSE TO OFFICE ACTION

This filing is responsive to the office action July 30, 2003. The response is filed 2 months in extension. Therefore a payment of \$210.00 is filed for a small entity using the Credit Card payment procedure. Applicant has faxed his response using the number 703-872-9310 along with which the CREDIT CARD PAYMENT IS INCLUDED AS THE LAST PAGE OF THIS TRANSMISSION. If for any reason this fee is incorrect, Applicant respectfully requests the right to pay the proper fee in a timely fashion.

Summary of Examiner's Office Action:

The office action of the Examiner of which this is a response is from July 30, 2003. The office action was non-final. Claims 1-3 were pending and claims 1-3 were rejected. The reference cited in this office action was Marchese(2,732,065-Jan 24, 1956). Examiner states that Applicant's arguments are moot in view of the new ground(s) of rejection. Claim 1 was rejected under 35 USC 102(b) as being anticipated by Marchese. And Claims 1-3 were rejected under 35 USC 103(a) as being obvious with respect to Marchese and therefore unpatentable over Marchese.

Due to an unclear reference in the Examiner's arguments of 7/30/2003 that refer to the Marchese prior art, Applicant made a good faith effort to call the Examiner to request an interview prior to an extension deadline. In addition, and at the very same time, October 23, 2003, in advance of the deadline for a non fee response of more than one week, Applicant faxed the

Examiner a sample instruction guide from a recently released commercially sold version of the patent applied for device in the interest of making sure Examiner fully comprehended the novel structure of the invention, it's intention and its use prior to the requested interview so that the interview would benefit from the descriptive material. In all due respect, Applicant was sufficiently unsure that the Examiner fully understood the unexpected and delightful result of using the Applicants invention as claimed and believed that the use of the demonstration material would enable a more productive interview.

The requested interview was finally granted but not timely for the extension deadline and at the time of the interview, Examiner stated he had still not received the fax sample instruction and explanation. Applicant received the telephone interview, and as a result and in response to Applicant's arguments, the Examiner simply modified his incorrect reference numbers as they related to the Marchese Figure 4 but did not entertain any discussion about the novelty of Schwartz with respect to Marchese. In the office action the Examiner bases his whole argument of rejection on Marchese and in the eleventh hour of a non-fee response window chose to fix his reference numbers after the non-fee response deadline had passed. Applicant wishes to state respectfully that the confusing references were both a disadvantage to the Applicant in forming his response, misleading to the Applicant, as well as costly to the Applicant. Applicant further respectfully wishes to point out that in no case has the Examiner directly responded to the Applicant's arguments, but rather has submitted case after case and in each instance stating that Applicants arguments are moot in light of the new art which has been offered. In so far as the Examiner is now basing his entire rejection on Marchese, and the below arguments refute Marchese, Applicant sincerely hopes and in all due respect requests a complete discussion on the merits of the Applicant's arguments and claims as filed.

Applicant's response below is now timely made with respect to the arguments as modified by the Examiner.

Applicant's Response

Applicant's response, therefore is in reference to the FAXED revision of the Examiner's original rejection, which FAX was received here on Nov 5th 2003. Applicant respectfully traverses the rejection of Claim 1 as being anticipated

by Marchese. Applicant claims a label strip device as an integrally formed structural member only with three connected component portions, each portion of which has a very specific dimensional relationship to the others. Marchese shows a tape strip of a substantial multiple or plurality of structural elements as part of a continuous strip separated by perforations. Marchese discloses a plurality of SETS OF TWO (please refer to the quote selected from Marchese below). The election of a random group of 3 of these taken in combination is not disclosed or taught in Marchese and therefore Schwartz is novel with respect to Marchese and therefore not anticipated by Marchese. Applicant respectfully proposes that the Marchese structure in no way anticipates Schwartz. Please refer to the Marchese Patent and the text selected below in which the structural elements of Marchese are clearly taught to be separable in a very specific manner that makes it clear how uniquely different Marchese is from Schwartz.

He states in column 3 -

QUOTE from MARCHESE:::::

"the tape has score marks or equivalent weakened lines 28 extending transversely thereof, to facilitate the removal of tape portions 30,32 respectively. The arrangement of the score markings is of importance, and is shown in Fig. 4, a pair of score lines 28 is provided, in closely spaced relation along the length of the tape. Between the score lines 28 of each pair, a relatively short tape portion 32, which can appropriately be termed the heel portion, is defined, and this portion would be applied to the heel of the shoe as shown in Fig. 5. Then, between the pairs of score lines, elongated tape portions 30 that constitute sole portions are defined."

Therefore, it is abundantly clear that Marchese teaches the election of two tape portions one smaller than the other, from a continuous strip. There is no stated teaching that would suggest any other election of Marchese elements, not one, not three, not five, not seventeen, so to suggest the election of any three as anticipating Schwartz is respectfully questioned. Further, in no are the disclosed short strips taught to be of sufficient length to overlap one another to permit the completion of a sticky loop.

Applicant holds that Marchese cannot anticipate Schwartz because Schwartz

is novel with respect to Marchese for both reasons stated above. Based on the original or the revised argument of the Examine, Applicant respectfully traverses Examiners rejection under 35 USC 102(b) and respectfully requests that the Examiner reconsider and allow claim #1 as claimed and permit it to publish in due course.

Claims 1-3 were rejected under 35 USC 103(a) with respect to Marchese as being obvious with respect to Marchese. Applicant respectfully calls forth the matter detailed above which clearly and unequivocally shows that Marchese teaches a structure that is a two element election, each of which parts of the two element unit is to be separated and applied as individual components in his intended application on a shoe heel and sole. It would not have been obvious to select three strips from Marchese from the pictorial disclosure nor from the specification disclosure. Further, since the specific sizes of the parts disclosed and their method of selection disclosed would not suggest nor make obvious in any manner, the creation of wing portions as in Schwartz of such length that they overlap one another to form a loop, the unobvious aspect of Schwartz becomes evident. Schwartz provides not only a novel strip of solely three elements, the elements of Schwartz are constrained in a novel way with respect to Marchese. It would have required one skilled in the art to first decide that the selection of three elements instead of five or seventeen should be made, and then to require that the relationship of the lengths of two of the three elements be specific one to the other. This requires two inferences from Marchese neither of which is disclosed or taught and therefore, Applicant suggests that this leap of two inferences is does not render Schwartz obvious from Marchese. Schwartz specifically discloses the formation of a three section tape strip as an integral structure with component parts separated by readily foldable hinges where the three components have the claimed algorithmic relationship to one another, and therefore, one skilled in the art would not readily determine from the disclosed figure 4 and the perforation separations 28 that a three element structure with wing panels that had a length such that they would overlap one another when folded in upon themselves would be an obvious leap from Marchese fig.4.

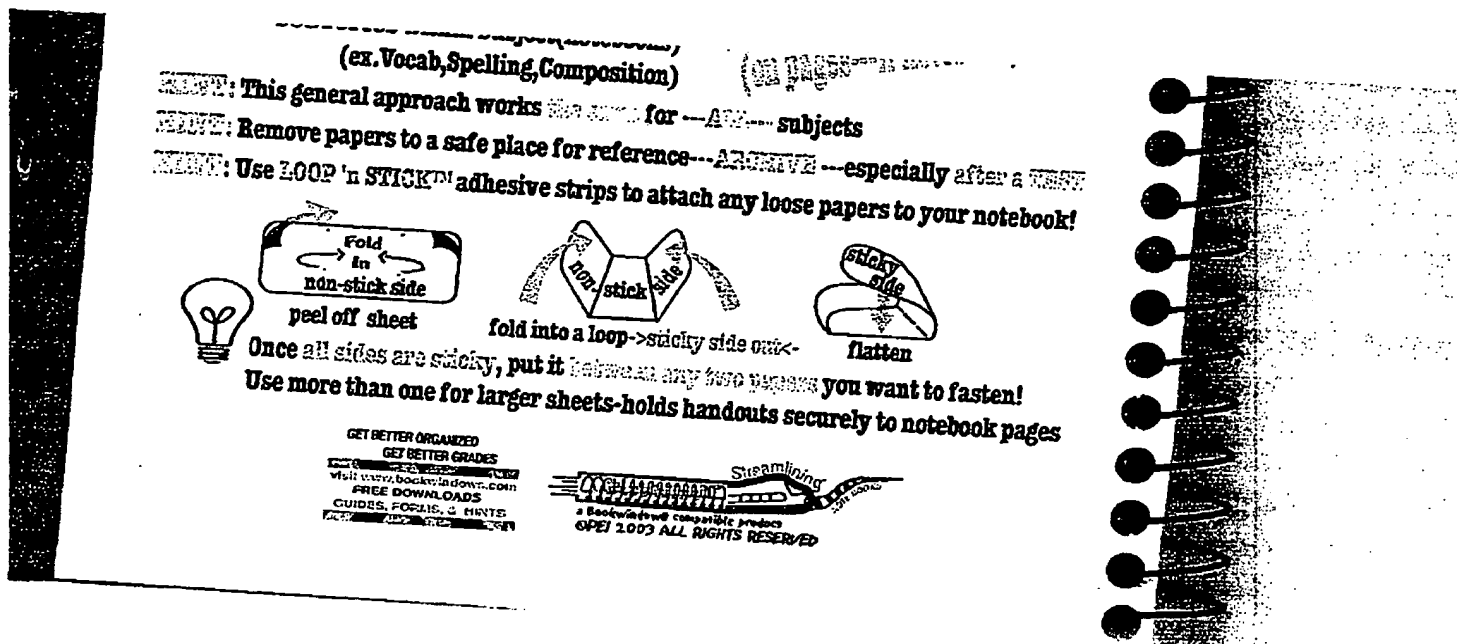
Applicant sincerely requests that the Examiner now look at the instruction sheet which is attached hereto to ensure that the unobvious benefit of the proposed structure is completely clear and understood in the preparation of

any response other than the respectfully requested allowance as stated above. The diagram demonstrating the use of Applicant's invention is attached as the final page of this transmission. It is in the interest of Applicant's arguments that Schwartz is not obvious in the most fundamental sense, as it was at the direction of mass retail merchandising executives at the customer that is retailing this product, that the explanation be provided because it was believed that the stationery consumer would benefit from an explanation because the device was not obvious. Applicant suggests this three sequence diagram is the answer to that merchandising request and hopes it is useful to the Examiner for the purpose at hand.

On the basis stated above, the traversal of the obviousness rejections, applicant respectfully traverses the Examiner's argument that claims 1-3 should be rejected on the basis of obviousness with respect to Marchese and respectfully requests that the claims 1-3 as claimed be allowed and permitted to publish in due course.

Applicant submits that the invention as originally disclosed and as now claimed is novel with respect to the prior art cited for the reasons explained above and therefore not anticipated by any prior art known and/or disclosed and that this patent application describes a device with is not only novel, but unique enough to provide a surprising unobvious outcome when used and therefore not obvious from its own representation nor from any prior art known and/or disclosed, and that the patent application with claims as provided be allowed and permitted to publish in due course.

Instructional summary which was faxed to the Examiner for the purpose of the above mentioned interview, and because they were stated as not being received, are reattached here for reference.



Sincerely,

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